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10/805,695

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Paul V. Greco

GRECO-001

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SUITE 407

STAMFORD, CT 06902

EXAMINER

LEFF, STEVEN N

ART UNIT

PAPER NUMBER

1761

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/805,695

Applicant(s)

GRECO ET AL.

Examiner

Steven Leff

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - The phrase “significant degradation” in claim 6 is rejected, as it is a relative term, which renders the claim indefinite. The term “significant degradation” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what is encompassed by the phrase “significant degradation”; it is unclear as to what degree of difference is encompassed by this phrase, if “degraded”.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-4, 8-13, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Arcari (GB 2247001).

With respect to claims 1-4, 8-13, and 18-19, Arcari teaches a body portion comprising overlying layers of porous material (pg. 4 line 10+) that are joined to form at least one compartment (pg. 4 line 15+), said at least one compartment carrying infusion beverage product (pg. 4 line 5), such as coffee, tea, or milk powder (pg. 4 line 11+), in addition to a weight that causes said body portion to sink in water (pg. 4 line 6+). It is noted that the weight in this instance is taken to be the weight of the bag material itself in

addition to the contents after the contents have absorbed an amount of water which in turn causes the bag to sink. Arcari further teaches that the at least one compartment carries an agent that imparts flavor into a solution during steeping (pg. 4 line 6+), that the layers of porous material are joined together by stitching to form the at least one compartment, and that the at least one compartments comprises a first compartment distinct from a second compartment, where the first compartment carries an infusion beverage and the second compartment carrying the weight.

Arcari further teaches that the weight comprises a dissolvable agent, where the dissolvable agent comprises a sweetener, such as sugar (pg. 4 line 7+). In addition, the porous material comprises a sheet of fibrous cellulosic material which withstands immersion into boiling water without damage, as well as being non-toxic, odorless, and flavorless. Regarding claim 10, Arcari teaches that the envelope is made of "perforated paper" (pg. 4 line 10+) where paper is made from cellulose.

With respect to claim 11, Arcari teaches that the pouch (7) is "placed into a container of hot or boiling water" (pg. 4 line 19+). Therefore, since the package of Arcari is intended to be used in an environment, which includes boiling water without degrading the package, Arcari would be expected to meet the limitations of claim 11.

Arcari continues by teaching that the beverage package includes a string anchored to the body portion at one end of the string and a tag at the other end of the string (pg. 4 line 17).

- Claims 1, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kasket (3257212).

With respect to claims 1 and 10-11, Kasket (3257212) teaches a non-floating beverage package, which will remain fully immersed in the infusion liquid and resist any tendency to float (col. 1 line 31+). Kasket continues by teaching a body portion, which comprises overlying layers of porous material (col. 2 line 5+) that are joined to form at least one compartment (col. 1 line 61+), said at least one compartment carrying infusion beverage product (col. 1 line 10+), in addition to a weight that causes said body portion to sink in water. It is noted that in this interpretation "a weight" is taken to be the water, which enters the porous compartment when the package is placed within a liquid, which causes the body portion to sink in the liquid.

Regarding claim 10, Kasket teaches that the envelope is made of "porous paper mats" (pg. 2 col. 1 line 5+) where paper is made from cellulose and with respect to claim 11, Kasket teaches that the pouch (7) is "impervious to hot water" and does not leave any taste itself to the beverage. (col. line 11+) Therefore, since the package of Kasket is intended to be used in an environment which includes hot water without degrading the package, and further since the word "hot" is a descriptive term which describes boiling water, Kasket would be expected to meet the limitations of claim 11.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309) as evidenced by [www.mightybeancoffee.com](http://www.mightybeancoffee.com) ("Tea Rock" teabag weight, March 2004).

Arcari is taken as above.

Kasket is taken as above.

With respect to claims 5-7 Kim teaches a method of manufacturing a weight for preventing water pollution which is made of a ceramic material, and which is converted to a pure earth material for its art recognized and applicant's intended function of providing a ceramic weight which is non-toxic, insoluble, odorless, and flavorless is a

liquid environment (abstract). With respect to the limitation that the weight is within the same porous body portion as the infusion beverage product, it is noted that Kim teaches the use of a ceramic weight, not merely in a porous body, but where the weight is not in any manner separated from the surrounding liquid due to the fact that the material has been treated to insure that the material does not degrade.

With respect to claim 5, Kasket (3257212) teaches a non-floating beverage package, which will remain fully immersed in the infusion liquid and resist any tendency to float (col. 1 line 31+). Kasket continues by teaching a body portion, which comprises overlying layers of porous material (col. 2 line 5+) that are joined to form at least one compartment (col. 1 line 61+), said at least one compartment carrying infusion beverage product (col. 1 line 10+), in addition to a weight that causes said body portion to sink in water. It is noted that in this instance the weight is taken to be the weight described on lines 37+ of column 2, where the weight is a non-toxic, water-insoluble substance (col. 2 line 38), however Kasket does not specifically recite that the weight may be within the same porous body portion as the infusion beverage product.

However with respect to claim 5, it would have been obvious to one of ordinary skill in the art to incorporate the weight, which Kasket discloses, into the invention of Arcari, since Arcari already teaches a weight within a porous compartment, and since Kasket teaches using a non-toxic, insoluble material as a weight. It would have further been obvious due to the fact that is noted that "a weight" further increases the rate at which all of the gases are forced to exit the infusible substance when immersed in the liquid, and thereby increases the density of the infusible substance as compared to water. Due to this increased weight and density, the package is forced to sink to the bottom of the container in a timelier manner, as opposed to "a weight" which requires the release of gases itself prior to acting as a weight. Subsequently the package is unable to float and therefore further avoids the need for steeping.

Further it would have been obvious due to the fact that providing the non-toxic, and insoluble material directly within the compartment which houses the infusion product, would allow for an overall reduction in the amount of material required due to the fact that only a single body portion is needed to house both the substance and a weight since the weight is non-toxic, and therefore would not harm the consumer and thus subsequently decrease the overall cost of the product since the amount of needed

material is reduced. In addition, by providing the weight within the same body, the package becomes a one-time use package and thus increases the number of overall sales since the weight may not be re-used.

Regarding claims 6 and 7, although both Arcari, and Kasket are silent to the use of a weight material which can be heated by microwave radiation in a microwave oven without significant degradation, both Arcari and Kasket teach "a weight", where Kasket further teaches a non-toxic, naturally occurring weight material, though Kasket further silent to the use of ceramic as the specific weight material. However Kim does specifically teach a ceramic weight material for its art recognized and applicant's intended function of, not only causing the body to sink in a liquid, but further in order to provide a weight, which is, non-toxic, insoluble, odorless, flavorless and will not degrade. Therefore it would have been obvious to one of ordinary skill in the art to substitute the weight material of Kasket, with the weight material as taught by Kim, due to the fact that both are insoluble, non-toxic and flavorless materials, Kim has treated the weight material with extreme heat thereby producing a pure ceramic and thus Kim has increased the number of different application to which the ceramic material may be applied, including as a microwave safe material, as ceramic is well known in the art as a microwave safe material which is used as a weight for helping a tea bag sink, as is further evidence by the "Tea Rock" teabag ceramic weight described by [www.mightybeancoffee.com](http://www.mightybeancoffee.com) (March 2004). Therefore Kim is relied upon for the express purpose of replacing the metal weight of Kasket, where Kasket teaches a non-toxic metal weight and where Kim further teaches a microwave safe, non-toxic material.

Further with regard to claim 6, although Kim is silent to the fact that the material will not significantly degrade when exposed to microwave radiation, it is noted that Kim teaches the specific material, i.e. ceramic, as is recited by claim 7, from which claim 6 depends, and further teaches the material is being treated for its art recognized and applicant's intended function of preventing significant degradation to the weight material when exposed to different extreme conditions while infusing a beverage, as is further evidence by the "Tea Rock" teabag ceramic weight described by [www.mightybeancoffee.com](http://www.mightybeancoffee.com) (March 2004) and thus it would be expected to meet the limitations of claim 6, where Kim is relied upon for the express purpose of replacing the metal weight of Kasket, which may be toxic under extreme conditions.

- Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Luckhaupt (2193974).

Arcari is taken as above.

With respect to claim 14 Luckhaupt teaches “an improved package for packaging and utilization of infusing material such as tea, coffee, and the like.” (pg. 1 col. 1 line 2+). More specifically Luckhaupt teaches, at figure 10, that the tag may carry product indicia.

Therefore with respect to claim 14 it would have been obvious to one of ordinary skill in the art to provide the product indicia on the string tag of Luckhaupt into the string tag of Arcari since both are directed to infusible packages, and a string and tag attached to the infusible package in order to remove the infusible package from the liquid, and further since the product indicia would allow the consumer to identify the product. It is further noted that MPEP 2144.04 (I) states “that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art”.

- Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Rambold. (3542561)

Arcari is taken as above.

With respect to claims 15-17 Rambold teaches an “infusion bag containing an infusible substance such as tea, coffee or the like for preparing a beverage.” (pg. 1 col. 1 line 21+) More specifically Rambold teaches “an infusion bag comprising at least three chambers all containing infusible substance with two outer chambers connected by a closure. At least one of the chambers has a transverse bend so as to allow the bag to be packaged in a flat condition. During use the bag is in a generally polygonal ring-like form with the lateral chambers spread apart.” (abstract)

With respect to claims 15-17, although Arcari teaches a compartmentalized infusion beverage package, which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Arcari is silent to the fact that a hinge separates two body



portions. Rambold does teach a bottom wall which folds for packaging and separates two body portions. Therefore, although Arcari does not teach two body portions that extend from a hinged interface, or a bottom wall which may be folded for packaging, one of ordinary skill would have been motivated to combine the teachings of Kasket and Rambold in order to produce an infusion beverage package which is capable of being more easily and compactly packed for distribution thus decreasing the overall size of the package and increasing the number of packages in a given area due to the body portions by being folded together into a relatively flat condition as Rambold teaches (abstract).

Regarding claim 16, although Arcari teaches a compartmentalized infusion beverage package which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Arcari is silent to the fact that two body portions are separated by a hinge, however Arcari does teach that the overall package contains a third bottom compartment containing a weight. Where Rambold does teach two body portions that extend from a hinged interface and further teaches a third "bottom" compartment. In addition, both references teach infusion beverage packages, which would allow for preparation of a beverage, Rambold teaches providing a space that would allow the liquid to flow between the compartments due to the separation of the bodies, where providing more than one chamber would cause the infusion substance to be spread out over a number of chambers and consequently over a larger surface area, thus producing a thinner layer of the substance. A thinner layer of the substance will consequently allow the infusion substance to be more effectively extracted by the infusing liquid. The weight in the bottom wall would increase the overall weight of the package thus preventing floating and causing the package to be completely submerged in the infusing liquid. Therefore, one of ordinary skill would have been motivated to combine the teachings of Arcari and Rambold in order to produce a hinged area between two separate bodies where the two bodies are further separated by a third body forming a bottom wall and containing a weight in order to cause the package to be more conducive to attaining the most advantageous rate of flow through the package and through the infusing substance thus allowing the same concentration of the beverage to be attained in a shorter amount of time as is taught by Rambold (col. 2 line 45+).

Therefore with respect to claims 15-17, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have produced a beverage infusion package, which includes a weight and further where the package could be folded for packaging and increasing the effectiveness of the package.

### ***Response to Arguments***

Applicant's arguments, see page 6, filed 5/04/07, with respect to the rejection(s) of claim(s) 1, 4-7, and 10-11 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn, as well as subsequent 103(a) rejections. However, upon further consideration, a new ground(s) of rejection is made in view of the different interpretation of claim 1. Applicant's arguments with respect to claims 8 and 16 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is further noted that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rambold is being relied upon to teach a compartmentalized foldable tea bag where one of the compartment extends between the two bodies thereby allowing the solution to better flow through, as is explicitly stated on column 2 line 39+.

It is further noted that claim 1 reads on practically any tea bag ever made, and more particularly if any bag with a sweetener.

### ***Allowable Subject Matter***

There is no allowable subject matter at this point


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL

  
**KEITH HENDRICKS  
PRIMARY EXAMINER**